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09/938,649	08/27/2001	Helen O'Hara	021058/0257402	3549
909 7590 07/22/2009 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER FELTON, AILEEN BAKER				
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/938,649
Filing Date: August 27, 2001
Appellant(s): O'HARA ET AL.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/13/2009 appealing from the Office action mailed 4/11/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,076,867 McKenzie 12-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 60-78 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McKenzie (5,076,867).

McKenzie discloses a water-in-oil emulsion that is formed by mixing nitrite, oxidizer salt, and thiourea and subsequently adding this solution to the emulsifier and the fuel (see col. 4, lines 30-68). PIBSA is disclosed as the surfactant. The amounts of each component are indicated in col. 2 and 3. Col. 4, lines 44-50 also indicates that microballoons can be used in addition to the thiourea/nitrite combination.

Alternatively, It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the parameters of the emulsion such as pH, amounts and density to achieve a desired result. It is well-settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Further, it would have been obvious to vary the order of the steps of addition of gasser solution to the emulsion explosive. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results) and *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious). See MPEP 2144.04(IV)(C).

(10) Response to Argument

Applicants' arguments that McKenzie is not the same type of emulsion as that of the instant invention are unpersuasive. Applicant argues that McKenzie discloses adding the nitrite to the thiourea (accelerator), this is not correct since McKenzie does

say that the aqueous portion "may contain a gassing accelerator. Also note that claim 60 does not require an accelerator since the claim recites "optionally an accelerator". McKenzie states at col. 4, lines 52-62) "The emulsion of the present invention may be formulated in a conventional manner. Typically, the oxidizer salt(s) and other aqueous soluble constituents first are dissolved in the water (or aqueous solution of water and miscible liquid fuel) at an elevated temperature of from about 25.degree. C. to about 90.degree. C. or higher, depending upon the crystallization temperature of the salt solution. The aqueous solution, which may contain a gassing accelerator, then is added to a solution of the emulsifier and the immiscible liquid organic fuel, which solutions preferably are at the same elevated temperature, and the resulting mixture is stirred with sufficient vigor to produce an emulsion of the aqueous solution in a continuous liquid hydrocarbon fuel phase." (emphasis added). So McKenzie discloses mixing the nitrite with oxidizer and possible an accelerator and then adding them to the emulsion. Applicant presents arguments regarding the disclosure of the amounts and use of microballoons and states that these are not relevant to the invention. The Examiner disagrees and they are included in the Office Action to meet the limitation of claim 77 which adds additional microballoons.

Further, there is no evidence that rebuts the 35 U.S.C. 103 rejection that has been set forth which indicates that is obvious to vary the order of the steps of addition of gasser solution to the emulsion explosive. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results) and *In re Gibson*, 39 F.2d 975, 5

USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious). See MPEP 2144.04(IV)(C). Applicant makes general allegations of unexpected results but provides no evidence of any such results. Note that attorney arguments cannot substitute for these results.

Applicant further argues that McKenzie uses PIBSA as a surfactant and not as the emulsifier. This is not persuasive since if the chemical is added to the composition, it will function as an emulsifier. The fact that McKenzie uses any additional emulsifiers is not relevant since the claim scope is "comprising" and allows for additional components. It is irrelevant whether one calls PIBSA an emulsifier or a surfactant, its properties cannot be removed from it by calling it by another name.

Applicant argues that it would not be obvious to vary the parameters of the emulsion such as pH, amounts and density to achieve a desired result. However, note the case law: It is well-settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. In *re* Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), In *re* Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Further, there is no evidence to suggest that these properties would not be inherent to the emulsion or that it would not be obvious to attain them through routine experimentation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Aileen Felton/

Primary Examiner

Conferees:

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